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10/659,710	09/11/2003	Luis Lopez-Molina	2312-113	4763

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT PAPER NUMBER

1638

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,710	<b>Applicant(s)</b> LOPEZ-MOLINA ET AL.	
	<b>Examiner</b> Cynthia Collins	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on September 11, 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3 and 24, drawn to methods of transforming plant cells wherein the plant cells are obtained from a transgenic plant having a downregulated level or activity of ABI5, A815 homolog or ABI ortholog, wherein the downregulation is under the control of a gene cassette for the activation and removal of a nucleic acid sequence in a transgenic plant wherein said nucleic acid sequence downregulates the level or activity of ABI5, ABI5 homolog or ABI5 ortholog protein, classified in class 435, subclass 469, for example.
- II. Claims 4 and 25, drawn to methods of transforming plant cells wherein the plant cells are obtained from a transgenic plant having a downregulated level or activity of ABI5, A815 homolog or ABI ortholog, wherein the transgenic plant comprises a T-DNA insertion in an ABI5, ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, classified in class 800, subclass 294, for example.
- III. Claims 5 and 26, drawn to methods of transforming plant cells wherein the plant cells are obtained from a transgenic plant having a downregulated level or activity of ABI5, A815 homolog or ABI ortholog, wherein the transgenic plant comprises a transposon insertion in an ABI5, ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, classified in class 435, subclass 468, for example.

- IV. Claims 6 and 27, drawn to methods of transforming plant cells wherein the plant cells are obtained from a transgenic plant having a downregulated level or activity of ABI5, ABI5 homolog or ABI ortholog, wherein the transgenic plant comprises an interfering RNA to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, classified in class 800, subclass 278, for example.
- V. Claims 7 and 28, drawn to methods of transforming plant cells wherein the protein level or activity of ABI5, ABI5 homolog or ABI ortholog in the plant cells is downregulated, wherein the transgenic plant comprises an overexpressed negative regulator of ABI5, ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, classified in class 435, subclass 469, for example.
- VI. Claims 9 and 30, drawn to methods of transforming plant cells wherein the plant cells are obtained from a transgenic plant having a downregulated level or activity of ABI5, ABI5 homolog or ABI ortholog, wherein the transgenic plant comprises a downregulated level or activity of a protein that modulates expression of ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, wherein the plant comprises a T-DNA insertion in the modulating protein to downregulate the modulating protein, classified in class 800, subclass 294, for example.
- VII. Claims 10 and 31, drawn to methods of transforming plant cells wherein the plant cells are obtained from a transgenic plant having a downregulated level or activity of ABI5, ABI5 homolog or ABI ortholog, wherein the transgenic plant comprises

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a downregulated level or activity of a protein that modulates expression of ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, wherein the plant comprises a transposon insertion in the modulating protein to downregulate the modulating protein, classified in class 435, subclass 468, for example.

- VIII. Claims 11 and 32, drawn to methods of transforming plant cells wherein the plant cells are obtained from a transgenic plant having a downregulated level or activity of ABI5, A815 homolog or ABI ortholog, wherein the transgenic plant comprises a downregulated level or activity of a protein that modulates expression of ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, wherein the plant comprises an interfering RNA to downregulate the modulating protein, classified in class 800, subclass 278, for example.
- IX. Claims 12 and 33, drawn to methods of transforming plant cells wherein the plant cells are obtained from a transgenic plant having a downregulated level or activity of ABI5, A815 homolog or ABI ortholog, wherein the transgenic plant comprises a downregulated level or activity of a protein that modulates expression of ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, wherein the plant comprises an overexpressed negative regulator of the modulating protein to downregulate the modulating protein, classified in class 435, subclass 469, for example.
- X. Claims 15 and 36, drawn to methods of transforming plant cells wherein the protein level or activity of ABI5, A815 homolog or ABI ortholog in the plant cells

is downregulated , wherein the plant cells are incubated with a plant vector which comprises a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog to produce the downregulated condition, wherein the DNA sequence is located in a gene cassette for the activation and removal of the DNA sequence in a transgenic plant, classified in class 800, subclass 294, for example.

- XI. Claims 16 and 37, drawn to methods of transforming plant cells wherein the protein level or activity of ABI5, A815 homolog or ABI ortholog in the plant cells is downregulated , wherein the plant cells are incubated with a plant vector which comprises a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog to produce the downregulated condition, wherein the DNA sequence comprises ABI5, ABI5 homolog or ABI5 ortholog lacking an activation domain, classified in class 435, subclass 468, for example.
- XII. Claims 17 and 38, drawn to methods of transforming plant cells wherein the protein level or activity of ABI5, A815 homolog or ABI ortholog in the plant cells is downregulated , wherein the plant cells are incubated with a plant vector which comprises a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog to produce the downregulated condition, wherein the DNA sequence produces a hairpin RNA sequence homologous to ABI5, ABI5 homolog or ABI5 ortholog to downregulate ABI5, ABI5 homolog or ABI5 ortholog, classified in class 800, subclass 285, for example.
- XIII. Claims 19 and 40, drawn to methods of transforming plant cells wherein the protein level or activity of ABI5, A815 homolog or ABI ortholog in the plant cells

is downregulated , wherein the plant cells are incubated with a plant vector which comprises a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog to produce the downregulated condition, wherein the DNA sequence downregulates the level or activity of a protein that modulates expression of ABI5, ABI5 homolog or ABI5 ortholog to downregulate ABI5, ABI5 homolog or ABI5 ortholog, wherein the DNA sequence comprises the modulating protein lacking an activation domain, classified in class 435, subclass 469, for example.

XIV. Claims 20 and 41, drawn to methods of transforming plant cells wherein the protein level or activity of ABI5, A815 homolog or ABI ortholog in the plant cells is downregulated , wherein the plant cells are incubated with a plant vector which comprises a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog to produce the downregulated condition, wherein the DNA sequence downregulates the level or activity of a protein that modulates expression of ABI5, ABI5 homolog or ABI5 ortholog to downregulate ABI5, ABI5 homolog or ABI5 ortholog, wherein the DNA sequence produces a hairpin RNA sequence homologous to the modulating protein to downregulate ABI5, ABI5 homolog or ABI5 ortholog, classified in class 800, subclass 285, for example.

XV. Claim 44, drawn to a transgenic plant comprising a downregulated protein level or activity of ABI5, ABI5 homolog or ABI5 ortholog, wherein the downregulation is under the control of a gene cassette for the activation and removal of a nucleic acid sequence in a transgenic plant wherein said nucleic acid

sequence downregulates the level or activity of ABI5, ABI5 homolog or ABI5 ortholog protein, classified in class 800, subclass 298, for example.

- XVI. Claim 45, drawn to a transgenic plant comprising a downregulated protein level or activity of ABI5, ABI5 homolog or ABI5 ortholog, wherein the transgenic plant comprises a T-DNA insertion in an ABI5, ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, classified in class 800, subclass 298, for example.
- XVII. Claim 46, drawn to a transgenic plant comprising a downregulated protein level or activity of ABI5, ABI5 homolog or ABI5 ortholog, wherein the transgenic plant comprises a transposon insertion in an ABI5, ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, classified in class 800, subclass 298, for example.
- XVIII. Claim 47, drawn to a transgenic plant comprising a downregulated protein level or activity of ABI5, ABI5 homolog or ABI5 ortholog, wherein the transgenic plant comprises interfering RNA to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, classified in class 800, subclass 298, for example.
- XIX. Claim 48, drawn to a transgenic plant comprising a downregulated protein level or activity of ABI5, ABI5 homolog or ABI5 ortholog, wherein the transgenic plant comprises an overexpressed negative regulator of ABI5, ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, classified in class 800, subclass 298, for example.



- XX. Claim 50, drawn to a transgenic plant comprising a downregulated protein level or activity of ABI5, ABI5 homolog or ABI5 ortholog, wherein the transgenic plant comprises a downregulated level or activity of a protein that modulates expression of ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, wherein the plant comprises a T-DNA insertion in the modulating protein to downregulate the modulating protein, classified in class 800, subclass 298, for example.
- XXI. Claim 51, drawn to a transgenic plant comprising a downregulated protein level or activity of ABI5, ABI5 homolog or ABI5 ortholog, wherein the transgenic plant comprises a downregulated level or activity of a protein that modulates expression of ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, wherein the plant comprises a transposon insertion in the modulating protein to downregulate the modulating protein, classified in class 800, subclass 298, for example.
- XXII. Claim 52, drawn to a transgenic plant comprising a downregulated protein level or activity of ABI5, ABI5 homolog or ABI5 ortholog, wherein the transgenic plant comprises a downregulated level or activity of a protein that modulates expression of ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, wherein the plant comprises an interfering RNA to downregulate the modulating protein, classified in class 800, subclass 298, for example.

XXIII. Claim 53, drawn to a transgenic plant comprising a downregulated protein level or activity of ABI5, ABI5 homolog or ABI5 ortholog, wherein the transgenic plant comprises a downregulated level or activity of a protein that modulates expression of ABI5 homolog or ABI5 ortholog to downregulate the ABI5, ABI5 homolog or ABI5 ortholog, wherein the plant comprises an overexpressed negative regulator of the modulating protein to downregulate the modulating protein, classified in class 800, subclass 298, for example.

XXIV. Claim 56, drawn to a plant vector comprising a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog in a host target plant cell, wherein the DNA sequence is located in a gene cassette for the activation and removal of a nucleic acid sequence in a transgenic plant, classified in class 435, subclass 320.1, for example.

XXV. Claim 57, drawn to a plant vector comprising a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog in a host target plant cell, wherein the DNA sequence comprises ABI5, ABI5 homolog or ABI5 ortholog lacking an activation domain to downregulate ABI5, ABI5 homolog or ABI5 ortholog, classified in class 435, subclass 320.1, for example.

XXVI. Claim 58, drawn to a plant vector comprising a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog in a host target plant cell, wherein the DNA sequence produces a hairpin RNA sequence homologous to ABI5, ABI5 homolog or ABI5 ortholog to downregulate ABI5, ABI5 homolog or ABI5 ortholog, classified in class 435, subclass 320.1, for example.

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XXVII. Claim 60, drawn to a plant vector comprising a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog in a host target plant cell, wherein the DNA sequence downregulates the level or activity of a protein that modulates expression of ABI5, ABI5 homolog or ABI5 ortholog to downregulate ABI5, ABI5 homolog or ABI5 ortholog, wherein the DNA sequence comprises the modulating protein lacking an activation domain, classified in class 435, subclass 320.1, for example.

XXVIII. Claim 61, drawn to a plant vector comprising a DNA sequence which downregulates ABI5, ABI5 homolog or ABI5 ortholog in a host target plant cell, wherein the DNA sequence downregulates the level or activity of a protein that modulates expression of ABI5, ABI5 homolog or ABI5 ortholog to downregulate ABI5, ABI5 homolog or ABI5 ortholog, wherein the DNA sequence produces a hairpin RNA sequence homologous to the modulating protein, classified in class 435, subclass 320.1, for example.

Claims 1 and 22 link(s) inventions I-XIII. Claims 2 and 23 link(s) inventions I-IX. Claims 8, 13, 29 and 34 link(s) inventions VI-IX. Claims 14 and 35 link(s) inventions X-XIII. Claims 18, 21, 39 and 42 link(s) inventions XIII-XIV. Claim 43 link(s) inventions XV-XXIII. Claims 49 and 54 link(s) inventions XX-XXIII. Claim 55 link(s) inventions XXIV-XXVI. Claims 59 and 62 link(s) inventions XXVII-XXVIII. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1, 2, 8, 13, 14, 18, 21, 22, 23, 29, 34, 35, 39, 42, 43, 49, 54, 55, 59 and 62. Upon the allowance of the linking

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claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Invention I and inventions VI-XIV and XVI-XXVIII are distinct inventions. The method of invention I does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XIV and XVI-XIII, or the plant vectors of inventions XXIV-XXVIII. The method of invention I requires a different method step (incubation with a vector) than the methods of inventions X-XIV. The method of invention I requires a different material (plant cells obtained from a different type of transgenic plant) than the methods of invention II-IX.

Inventions XV and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic plant can be used in a materially different process of using that product, such as a breeding method.

Invention II and inventions VI-XV and XVII-XXVIII are distinct inventions. The method of invention II does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XV and XVII-XIII, or the plant vectors of inventions XXIV-XXVIII. The method of invention II requires a different method step (incubation with a vector) than the methods of inventions X-XIV. The method of invention II requires a different material (plant cells obtained from a different type of transgenic plant) than the methods of invention III-IX.

Inventions XVI and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic plant can be used in a materially different process of using that product, such as a breeding method.

Invention III and inventions VI-XVI and XVIII-XXVIII are distinct inventions. The method of invention III does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XVI and XVIII-XIII, or the plant vectors of inventions XXIV-XXVIII. The method of invention III requires a different method step (incubation with a vector) than the methods of inventions X-XIV. The method of invention III requires a different material (plant cells obtained from a different type of transgenic plant) than the methods of invention IV-IX.

Inventions XVII and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case the transgenic plant can be used in a materially different process of using that product, such as a breeding method.

Invention IV and inventions VI-XVII and XIX-XXVIII are distinct inventions. The method of invention IV does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XVII and XIX-XIII, or the plant vectors of inventions XXIV-XXVIII. The method of invention IV requires a different method step (incubation with a vector) than the methods of inventions X-XIV. The method of invention IV requires a different material (plant cells obtained from a different type of transgenic plant) than the methods of invention V-IX.

Inventions XVIII and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic plant can be used in a materially different process of using that product, such as a breeding method.

Invention V and inventions VII-XVIII and XX-XXVIII are distinct inventions. The method of invention V does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XVIII and XX-XIII, or the plant vectors of inventions XXIV-XXVIII. The method of invention V requires a different method step (incubation with a vector) than the methods of inventions X-XIV. The method of invention V requires a different material (plant cells obtained from a different type of transgenic plant) than the methods of invention VI-IX.

Inventions XIX and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

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product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic plant can be used in a materially different process of using that product, such as a breeding method.

Invention VI and inventions VIII-XIX and XXI-XXVIII are distinct inventions. The method of invention VI does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XIX and XXI-XIII, or the plant vectors of inventions XXIV-XXVIII. The method of invention VI requires a different method step (incubation with a vector) than the methods of inventions X-XIV. The method of invention VI requires a different material (plant cells obtained from a different type of transgenic plant) than the methods of invention VII-IX.

Inventions XX and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic plant can be used in a materially different process of using that product, such as a breeding method.

Invention VII and inventions VIII-XX and XXII-XXVIII are distinct inventions. The method of invention VII does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XX and XXII-XIII, or the plant vectors of inventions XXIV-XXVIII. The method of invention VII requires a different method step (incubation with a vector) than the methods of inventions X-XIV. The method of invention VII requires a different material (plant cells obtained from a different type of transgenic plant) than the methods of invention VIII-IX.

Inventions XXI and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic plant can be used in a materially different process of using that product, such as a breeding method.

Invention VIII and inventions IX-XXI and XXIII-XXVIII are distinct inventions. The method of invention VIII does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XXI and XIII, or the plant vectors of inventions XXIV-XXVIII. The method of invention VIII requires a different method step (incubation with a vector) than the methods of inventions X-XIV. The method of invention VIII requires a different material (plant cells obtained from a different type of transgenic plant) than the method of invention IX.

Inventions XXII and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic plant can be used in a materially different process of using that product, such as a breeding method.

Invention IX and inventions X-XXII and XXIV-XXVIII are distinct inventions. The method of invention IX does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XXII, or the plant vectors of inventions XXIV-XXVIII. The method of



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invention IX requires a different method step (incubation with a vector) than the methods of inventions X-XIV.

Inventions XXIII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic plant can be used in a materially different process of using that product, such as a breeding method.

Invention X and inventions XI-XXIII and XXVI-XXVIII are distinct inventions. The method of invention X does not require the use of, or result in the production of, the transgenic plants of inventions XVI-XXIII, or the plant vectors of inventions XXIII and XXV-XXVIII. The method of invention X requires a different material (plant vector) than the methods of inventions XI-XIV.

Inventions XXIV and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the plant vector can be used in a materially different process of using that product, such as a hybridization method.

Inventions X and XV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be

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made by another and materially different process (MPEP § 806.05(f)). In the instant case the transgenic plant can be made by another and materially different process, such as whole plant transformation or transgenic breeding.

Invention XI and inventions XII-XXIV and XXVI-XXVIII are distinct inventions. The method of invention XI does not require the use of, or result in the production of, the transgenic plants of inventions XV-XXIII, or the plant vectors of inventions XXIV-XXIV and XXVI-XXVIII. The method of invention XI requires a different material (plant vector) than the methods of inventions XII-XIV.

Inventions XXV and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the plant vector can be used in a materially different process of using that product, such as a hybridization method.

Invention XII and inventions XIII-XXV and XXVII-XXVIII are distinct inventions. The method of invention XII does not require the use of, or result in the production of, the transgenic plants of inventions XV-XXIII, or the plant vectors of inventions XXIV-XXV and XXVII-XXVIII. The method of invention XII requires a different material (plant vector) than the methods of inventions XIII-XIV.

Inventions XXVI and XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the

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product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the plant vector can be used in a materially different process of using that product, such as a hybridization method.

Invention XIII and inventions XIV-XXVI and XXVIII are distinct inventions. The method of invention XIII does not require the use of, or result in the production of, the transgenic plants of inventions XV-XXIII, or the plant vectors of inventions XXIV-XXVI and XXVIII. The method of invention XIII requires a different material (plant vector) than the method of invention XIII.

Inventions XXVII and XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the plant vector can be used in a materially different process of using that product, such as a hybridization method.

Invention XIV and inventions XV-XXVII are distinct inventions. The method of invention XIV does not require the use of, or result in the production of, the transgenic plants of inventions XV-XXIII, or the plant vectors of inventions XXIV-XXVII.

Inventions XXVIII and XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case the plant vector can be used in a materially different process of using that product, such as a hybridization method.

Inventions XV-XXIII and inventions XXIV-XXVIII are distinct inventions. The transgenic plants of inventions XV-XXIII differ in composition from the plant vectors of inventions XXIV-XXVIII

Invention XXIV and inventions XXV-XXVIII are distinct inventions. The plant vector of invention XXIV differs in structure and functional mechanics from the plant vectors of inventions XXV-XXVIII.

Invention XXV and inventions XXVI-XXVIII are distinct inventions. The plant vector of invention XXV differs in structure and functional mechanics from the plant vectors of inventions XXVI-XXVIII.

Invention XXVI and inventions XXVII-XXVIII are distinct inventions. The plant vector of invention XXVI differs in structure and functional mechanics from the plant vectors of inventions XXVII-XXVIII.

Invention XXVII and invention XXVIII are distinct inventions. The plant vector of invention XXVII differs in structure and functional mechanics from the plant vector of invention XXVIII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

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The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

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Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins  
Primary Examiner  
Art Unit 1638

CC

  
2/1/06